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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/876,354

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Jody L. Terrill

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EXAMINER

WU, QING YUAN

ART UNIT

PAPER NUMBER

2194

MAIL DATE

DELIVERY MODE

04/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/876,354

**Applicant(s)**

TERRILL ET AL.

**Examiner**

Qing-Yuan Wu

**Art Unit**

2194

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7-14, 27-33, 37 and 39-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-8, 12, 27-32, 37 and 39-43 is/are rejected.
- 7) ☒ Claim(s) 9-11, 13-14 and 33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-5, 7-14, 27-33, 37 and 39-43 are pending in the application.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/11/08 has been entered.

***Allowable Subject Matter***

3. Claims 9-11, 13-14 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and overcoming the 112 2<sup>nd</sup> paragraph rejection below.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 27 and 29-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

6. Claim 27 fails to fall within a statutory category of invention, since it is directed to a software module itself (note: the peripheral server is for use with the claim software module and is not part of the software module. Applicant should consider claiming the peripheral server which includes the computer-readable media that stored the port monitor to overcome the rejection).  
Claims 29-30 dependent on claim 27 and are rejected for the same reason.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 14 and 39-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. The following terms lacks antecedent basis:
- i. the peripheral - claim 14.
  - ii. the document - claims 39-40.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant Admitted Prior Art (hereafter AAPA), in view of Kujirai et al (hereafter Kujirai) (US Patent 6,618,566).

11. Kujirai was cited in the last office action.

12. As to claim 27, AAPA teaches substantially to collect and correlate pre-print and post-print information [AAPA, pg. 1, line 23-pg. 2, line 4], the preprint information being obtained from a host operating system [AAPA, pg. 1, lines 25-26] and the post-print information being obtained from a peripheral device that is configured to print jobs [AAPA, pg. 2, lines 1-4] and to store the correlated pre-print information and post-print information for later reference [AAPA, pg. 2, lines 1-14].

13. AAPA does not specifically teach a port monitor that operates on a peripheral server that is configured to perform the recited functions. However, AAPA teaches a combination of peripheral server and management server that performs the functions as recited. It would have been obvious to one of an ordinary skill in the art at the time the invention was made, to have substitute the various components of AAPA with a component that is functionally equivalent to achieve the predictable result of collecting and correlating pre-print and post-print information.

14. Furthermore, AAPA does not specifically teach a job information module to assign unique job identifiers to print jobs. However, Kujirai teaches associating a job identifier with a print job

when spooling the print job in the spooler (prior to sending the job to a printing device) [Kujirai, col. 7, lines 24-51; 402, Fig. 4]. It would have been obvious to one of an ordinary skill in the art at the time the invention was made, to have combined the teaching of AAPA with the teaching of Kujirai because the teaching of Kujirai would improve the ease of identifying a print job with its corresponding job identifier.

15. Claims 1-5, 7-8, 12, 28-32, 37 and 39-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA and Kujirai as applied to claim 27 above, in view of Kassan et al (hereafter Kassan) (US PG Pub 20020161717A1).

16. Kassan was cited in the last office action.

17. As to claim 1, this claim is rejected for the same reason as claim 27 above. In addition, AAPA and Kujirai do not specifically teach correlating using the unique job identifier. However, Kassan teaches correlating information based on an identifier [Kassan, pg. 9, paragraph 173]. It would have been obvious to one of an ordinary skill in the art at the time the invention was made, to have combined the teaching of AAPA and Kujirai with the teaching of Kassan because the teaching of Kassan can improve the correlation of print information by simply matching/correlate print information based on the same identifier.

18. As to claim 2, AAPA as modified teaches the invention substantially as claimed including wherein the pre-print information is received from an operating system [AAPA, pg. 1, lines 25-26].

19. As to claim 3, AAPA as modified teaches the invention substantially as claimed including wherein the post-print information is obtained from the printing device [AAPA, pg. 2, lines 1-4].

20. As to claim 4, this claim is rejected for the same reason as claim 3 above. In addition, AAPA as modified teaches a facsimile machine [Kujirai, col. 17, lines 29-30].

21. As to claim 5, AAPA as modified does not specifically teach SNMP Gets. However, AAPA as modified disclosed an application in a management server that obtains the post-print information from the printer's job table [AAPA, pg. 2, lines 1-4]. It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have included various means of obtaining post-print information because doing so would increase the flexibility and compatibility of the system.

22. As to claim 7, AAPA as modified does not specifically teach sending the unique job identifier, the pre-print information and the post-print information to a job table on a peripheral. However, it would have been obvious to one of an ordinary skill in the art at the time the invention was made, to send the collected/correlated information to a different storage device for temporary storage prior to sending it to the management server.

23. As to claim 8, AAPA as modified teaches the invention substantially including sending the unique job identifier, the pre-print information and the post-print information to a management server [AAPA, pg. 2, lines 1-4; Kujirai, col. 5, lines 47-50].

24. As to claim 12, AAPA as modified does not specifically teach polling a peripheral to determine if the peripheral has finished with the print job. However, it would have been obvious to one of an ordinary skill in the art at the time the invention was made, to have recognized that post-print information cannot be obtained unless the print job is completed and provide a mean of communicating the completion.

25. As to claims 39-40, AAPA as modified teaches the invention substantially including wherein the pre-print information includes information as to an owner of the document and as to an application that was used to create the document [AAPA, pg. 1, lines 17-19].

26. As to claims 41-43, AAPA as modified teaches the invention substantially including wherein the post-print information includes information as to time required to print, quantity of toner used to print, and information as to success or failure of printing [AAPA, pg. 1, lines 20-22].

27. As to claims 28-30, these claims are rejected for the same reason as claims 1, 5 and 7-8.

28. As to claim 31, this claim is rejected for the same reason as claims 1-4 above. In addition AAPA as modified teaches sending the print job to a printer [Kujirai, col. 12, lines 51-53].



29. As to claim 32, this claim is rejected for the same reason as claims 4 and 12 above.

30. As to claim 37, this claim is rejected for the same reason as claim 31 above.

***Response to Arguments***

31. Applicant's arguments filed 1/11/08 have been fully considered but they are not persuasive.

32. In the remarks, Applicant argued in substance that:

- a. AAPA failed to teach a "port monitor" on a "peripheral server" that collects and correlates pre-print and post-print information.

33. Examiner respectfully traversed Applicant's remarks:

34. As to point (a), AAPA does not specifically teach a port monitor that operates on a peripheral server that is configured to perform the recited functions. However, AAPA teaches a combination of peripheral server and management server that performs the functions as recited (see mapping for claim 27 above), and further supported by applicant's argument filed 1/11/08 [remark pg. 10, line 19 to pg. 11, line 2]. One of an ordinary skill in the art at the time the invention was made, would be motivated to substitute the various components of AAPA with a component that is functionally equivalent to achieve the predictable result of collecting and correlating pre-print and post-print information.

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qing-Yuan Wu whose telephone number is (571)272-3776. The examiner can normally be reached on 8:30am-6:00pm Monday-Thursday and alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng Ai An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Meng-Ai An/  
Supervisory Patent Examiner, Art Unit 2195

/Qing-Yuan Wu/  
Examiner, Art Unit 2194